

APPLICANT(S): STELLACCI, Francesco
SERIAL NO.: 10/688,867
FILED: October 17, 2003
Page 14

REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1-2, 40, 49-50, 52, 57-58, 97, 106-107, 109, 111, 112, 145-146, 177-180, 182, 183, 215-216 are pending in the application. Claims 111, 112, 145-146, 177-180, 182, 183, 215-216 are withdrawn. Claims 1-2, 40, 49-50, 52, 57-58, 97, 106-107, 109 have been rejected.

Claim 1 and claim 57 have been amended. Support for the amendments can be found on page 4, left column, paragraph [0033] and on page 7, right column, paragraph [0073] of the published application disclosing the binding of the reactive functional group to the surface of the second substrate; and on page 4, right column, paragraph [0037] of the published application where the inert nature of the spacer is disclosed. Claims 49 and 97 have been amended. The amendments to claims 49 and 97 are editorial in nature.

New claims, claims 246 and 247 have been added. Support for the claims can be found on page 4, left and right columns, paragraph [0034] and on page 8, right column, paragraph [0080] of the published application, wherein a list of exposed functionalities is disclosed.

Claims 2 and 58 have been canceled without prejudice or disclaimer. In making this cancellation without prejudice, Applicants reserve all rights in this claim to file divisional and/or continuation patent applications.

Applicants respectfully assert that the amendments to the claims add no new matter.

APPLICANT(S): STELLACCI, Francesco
SERIAL NO.: 10/688,867
FILED: October 17, 2003
Page 15

CLAIM REJECTIONS

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1-2, 49-50, 52, 57-58, 106-107, 109 under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e), as being anticipated by Guire et al. [US 6,514,768].

Applicants have amended claims 1 and 57 to emphasize that the bonding of the reactive functional group of the second set of molecules with a second substrate, is done by forming a bond between the second set of molecules and the surface of a second substrate without the addition of mediators such as the binding partner or the polymerizable group disclosed in Guire. Applicants assert that the binding of the reactive functional group of the molecule to the surface of the second substrate precludes additional steps of coating the surface of the substrate by a "binding partner" as disclosed in Guire. Accordingly, Guire can not anticipate Applicants claimed invention.

Therefore, Applicants request withdrawal of the rejection.

Support for the amendments to claims 1 and to claim 57 can be found on page 4, left column, paragraph [0033] and on page 7, right column, paragraph [0073] of the published application disclosing the binding of the reactive functional group to the surface of the second substrate without the use of binding partners, coatings or polymerizable groups. In these paragraphs, numerous examples are given for functional groups (e.g. thiols) that binds upon contact to surfaces of substrates such as gold, silver, copper, etc.

Therefore, Applicants respectfully request withdrawal of the rejection to independent claims 1 and 57 and to claims 49, 50, 52, 106, 107 and 109 dependent thereon.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 40 and 97 under 35 U.S.C. § 103(a), as being unpatentable over Guire et al. [US 6,514,768] in view of Aksay et al. [US2001/0023024].

APPLICANT(S): STELLACCI, Francesco
SERIAL NO.: 10/688,867
FILED: October 17, 2003
Page 16

The Examiner alleged that "In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which Applicant relies...are not cited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims" (page 6 of the Office Action). As discussed above, Applicants have amended independent claims 1 and 57 to include these limitations from the specification showing the unique features of Applicants invention i.e. the binding of the second set of molecules to the surface of the second substrate and not to a binding partner or a polymerizable group, as disclosed in Guire.

Accordingly, Guire in view of Aksay do not render obvious Applicants claimed invention.

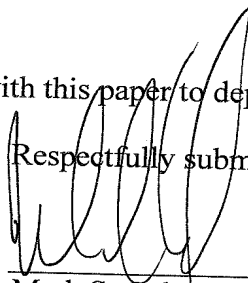
Therefore, Applicants request withdrawal of the rejection.

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,



Mark S. Cohen
Attorney/Agent for Applicant(s)
Registration No. 42,425

Dated: January 20, 2009

Pearl Cohen Zedek Latzer, LLP
1500 Broadway, 12th Floor
New York, New York 10036
Tel: (646) 878-0800
Fax: (646) 878-0801